

**REMARKS**

Claims 1 and 6 are pending in this application. By this Amendment, claim 1 is amended to further define the subject matter recited therein. The amendments to claim 1 are supported at least by Examples 1-3 in Table 2 on page 14 of the present specification, which uses "Silica 1" described in Table 1 on page 14 of the present specification to have a specific surface area of  $3 \text{ m}^2/\text{g}$ . No new matter is added by this Amendment.

Entry of the amendments is proper under 37 CFR §1.116 because the amendments: (a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issue requiring further search and/or consideration (as the amendments amplify issues previously discussed throughout prosecution); (c) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (d) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

**I. Rejections Under 35 U.S.C. §§102(e)/103(a)**

Claims 1 and 6 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by, or, in the alternative under 35 U.S.C. §103(a) as allegedly being obvious over, U.S. Patent No. 6,001,901 ("Shiobara"). Applicants respectfully traverse the rejection.

Applicants respectfully submit that Shiobara does not describe all the features of amended independent claim 1. Specifically, Shiobara does not describe silica particles having a particle size satisfying Equations (1)-(3) in claim 1 and a specific surface area of  $3 \text{ m}^2/\text{g}$ . Instead, Shiobara describes an epoxy resin composition comprised of silica particles having (1) a mean particle size of  $0.5$  to  $3 \text{ }\mu\text{m}$  and (2) a specific surface area of  $5$  to  $40 \text{ m}^2/\text{g}$ , or  $5$  to  $30 \text{ m}^2/\text{g}$ . See Shiobara, the Abstract and col. 5, lines 25-41.

Thus, the silica particles recited in Shiobara have a significantly higher specific surface area than recited in claim 1. As such, Shibara does not anticipate the subject matter recited in claim 1.

Furthermore, Shiobara provides (1) no reason or rationale to reduce the specific surface area of the silica particles described in Shiobara, and (2) no indication that reducing the surface area would achieve particles that still achieve their intended function in Shiobara. As such, one having ordinary skill in the art would have had no reasonable expectation of success in reducing the specific surface area of Shiobara's silica particles. Thus, Shiobara also cannot be found to have rendered claim 1 obvious.

Additionally, Shiobara also does not describe the anisotropically conductive adhesive film undergoes indentation of at least 10  $\mu\text{m}$  at a 1 kgf indentation strength, and undergoes indentation of at least 15  $\mu\text{m}$  at an indentation strength of 2 kgf, during thermocompression bonding for 20 seconds at 180°C, as recited in claim 1. Shiobara nowhere discloses, or teaches or suggests, these indentation values.

However, the Patent Office alleges indentation strength values are obvious via routine optimization. See Office Action, page 4. The Patent Office fails to establish that Shiobara provides any reason or rationale for one of ordinary skill to have attempted the creation of the anisotropically conductive adhesive film with the indentation strength values recited in claims 1 and 6. The mere allegation of optimizing clearly is not sufficient to establish that Shiobara would have provided one of ordinary skill in the art with reason or rationale to have created an anisotropically conductive adhesive film that undergoes indentation of at least 10  $\mu\text{m}$  at a 1 kgf indentation strength, and undergoes indentation of at least 15  $\mu\text{m}$  at an indentation strength of 2 kgf, during thermocompression bonding for 20 seconds at 180°C, as recited in claim 1.

To establish that optimization through routine experimentation would have been obvious, the Patent Office must establish that the relevant variables are known, or indicated, to be result effective, so that one of ordinary skill in the art would have had reason or rationale to have attempted to optimize the values to achieve the indicated result. Specifically, MPEP §2144.05 II B states that before optimization of a particular variable can be found obvious, the variable to be optimized must be described as achieving a particular result.

In the present case, Shiobara does not describe any indentation strength values, or indicate any result that may be achieved by adjusting these values, and thus also fails indicate that this property (indentation strength) would affect any particular characteristic of an anisotropically conductive adhesive film. Therefore, optimization of this value would not have been obvious from Shiobara.

Accordingly, independent claim 1 is not anticipated by Shiobara for at least the reasons discussion above. For these same reason, Shiobara would not have provided one of ordinary skill in the art with any reason or rationale to have derived the anisotropically conductive adhesive film recited in claim 1 with any reasonable expectation of success.

Dependent claim 6 therefore is also not anticipated by, and would not have been obvious over, Shiobara for at least the reasons discussed above regarding independent claim 1.

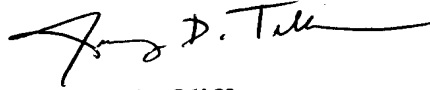
Reconsideration and withdrawal of the rejection are respectfully requested.

## **II. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1 and 6 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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